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P.B. 10.3.02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

AKIHIRO NAGATA ET AL

Serial No.: 09/008,675

Filed: January 16, 1998



METHOD AND SYSTEM FOR
TREATING A POWER TRANS-
MISSION BELT/BELT SLEEVE

Group Art Unit: 1724

Examiner: R. Hopkins

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REQUEST FOR REHEARING UNDER 37 CFR §1.197(b)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Appellant respectfully requests rehearing of the Board's August 22, 2002 Decision (Paper No. 14) in the above matter.

It appears that the Board has considered only the two independent claims, 1 and 14, in analyzing Issue No. 1, when in fact dependent claims 3-6, 10, 13, 16, 17, 21, 24, and 25, in addition to claims 1 and 14, require separate analysis with respect to Issue No. 1. A statement was made by Appellant, and acknowledged by the Examiner in his Answer, that the claims in each group of claims, corresponding to Issue Nos. 1-3, do not stand or

37 CFR 1.8
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fall together. Appellant explained in its Brief why the claims in Group I (claims 1, 3-6, 10, 13, 14, 16, 17, 21, 24 and 25) are separately patentable. Thus, it is respectfully submitted that the Examiner's rejection of each of claims 3-6, 10, 13, 14, 16, 17, 21, 24 and 25 should be separately considered by the Board.

Appellant respectfully submits that there is an additional point that the Board has misapprehended in rendering the Decision. The Board has interpreted the word "wrap" based upon a broad dictionary definition rather than interpreting this word in accordance with the Appellant's specification.

Without repeating the details of the structure claimed, Appellant notes that the "wrapping" of the vapor-impervious film, as in claim 1, is shown in Fig. 2 and described in the Appellant's specification at page 10, in lines 15-22. The Board concluded that the term "wrapping", as "broadly construed, encompasses the technique of collapsing an airtight material around a belt to envelop the belt" (Board Decision at pg. 4). The term "wrap" has been used consistently throughout the Appellant's specification as in definition 1 in the dictionary definition supplied by the Board, i.e. "to cover esp. by winding or folding". There is no disclosure in the Appellant's specification of an envelope or receptacle which the belt/belt sleeve could be inserted into to achieve the ends of the invention.

In interpreting claims, the Federal Circuit in Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d, 1576, 1582, 39 USPQ 2d 1573, 1577 (Fed. Cir. 1996), stated:

The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication . . . The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it.

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Thus, the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term. (our emphasis)

Further, in Beachcombers, International, Inc. v. WildeWood Creative Products, Inc., 31 F.3d 1154, 1161, 31 USPQ 2d 1653, 1658 (Fed. Cir. 1994), it was stated that correct interpretation of a patent claim in suit is:

directly supported by the body of the patent, a recognized tool of claim construction.

In view of this, Appellant submits that "wrapping", as recited in claim 1, should be interpreted consistently with Appellant's specification, i.e. as winding, rather than through the use of one of a number of dictionary definitions for the word "wrap" which is inconsistent with its use in the Appellant's application.

The courts cautiously approach the use of a dictionary definition of a word without specific reference to the specification. As noted in Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1478, 45 USPQ 2d 1429, 1433 (Fed. Cir. 1998):

Courts must exercise caution lest dictionary definitions, usually the least controversial source of extrinsic evidence, be converted into technical terms of art having legal, not linguistic, significance. The best source for understanding a technical term is the specification from which it arose, and formed, as needed, by the prosecution history. (our emphasis)

However, even if one were to interpret "wrapping" as to include an envelope into which the belt/belt sleeve is placed, this definition cannot be used with respect to the language in at least claims 13, 21 and 24. Claims 13 and 21 specifically recite the step of wrapping at least one sheet "spirally around a radially outwardly facing surface of the

belt/belt sleeve body". Claim 24 recites 2 to 4 layers of the film on the belt/belt sleeve body. Claims 13, 21 and 24 are alleged to be anticipated by Perkins. Regardless of the definition of "wrap", these claims are not anticipated.

In light of the above, reconsideration of the affirmance of the Examiner's rejection in the August 22, 2002 Decision on Appeal is requested.

Respectfully submitted,


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